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BY:

Victoria A Jones

DATE:

8/16/02

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Patent Application of : Group Art Unit 1713
Robert A. Rosania, *et al.* :
: Conf. No.: 7327 :
: Appln. No.: 09/641,745 : Examiner: Henry S. Hu
: Filed: August 18, 2000 :
: For: NEAR INFRARED ELECTROMAGNETIC: Attorney Docket
RADIATION ABSORBING : No. 9567-3US
COMPOSITION AND METHOD OF USE :

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RESPONSE TO RESTRICTION REQUIREMENT

This Response to Restriction Requirement is provided in answer to the Office Action mailed July 16, 2002 (Paper No. 8). This response is timely filed on August 16, 2002.

Claims 1-29 are pending in this application.

In Paper No. 8, the Examiner has required restriction among the claims of Group I (claims 1-19), drawn to a liquid composition for coating a surface, classified in class 524, subclass 216; the claims of Group II (claims 20-24), drawn to a method of reducing the reflection of "NIR" from the surface, classified in class 524, subclass 124+; the claim of Group III (claim 25) drawn to a surface article, classified in class 428, subclass 314.2+; and the claims of Group IV (claims 26-29) drawn to a copolymer product useful for coating a vehicle, classified in class 521, subclass 70+.

Citing M.P.E.P. §§ 806.04 and 808., the Examiner asserts that the inventions: (i) of Groups I and II are unrelated; (ii) of Groups II and III are unrelated; (iii) of Groups III and IV are unrelated; and (iv) of Groups II and IV are unrelated. In each case, the Examiner asserts that unrelatedness is present because, of the above-paired Groups (i) to (iv), the paired groups are "not disclosed as capable of use together and have different modes of operation, different functions, or different effects." Paper No. 8, ¶¶ 2-4 and 7. In each instance, the Examiner fails

to provide any further analysis or basis for his finding of “unrelatedness” under the cited portions of the M.P.E.P., but merely makes the conclusory assertion that “the metes and boundaries [of the claims] are distinct.” See, paper No. 8, ¶¶ 2-4 and 7.

Additionally, the Examiner states that the inventions of Group III and Group IV, are related as a combination and subcombination; however, he asserts that the related inventions are distinct because “the combination does not require the particulars of the subcombination as claimed and the combination has a utility by itself.” Paper No. 8, ¶ 5. Specifically, the Examiner argues that the “combination”, a “surface article,” does not require the particulars of the subcombination as claimed because “the surface can be on any article and with different shape and thickness.” *Id.* Further, the Examiner asserts that the subcombination (the composition) has separate utility, stating that it can be incorporated into plastics to make “a projection lens or television filter.”

Similarly, the Examiner asserts that, while the inventions of Group I and Group IV are related as combination and subcombination, they are “distinct because the copolymer can be mixed with different NIR absorbing compounds as additives, or the polymer itself is an NIR absorbing material and the subcombination has a separate utility in that can be incorporated into plastics to make projection lenses or television filters.” Paper No. 8, ¶ 6. The applicants respectfully traverse this restriction requirement, for the reasons set forth below.

With respect to the restriction requirement as applied to each of the inventions: (i) of Groups I and II; (ii) of Groups II and III; (iii) of Groups III and IV; and (iv) of Groups II and IV, the Examiner has failed to meet his requisite legal burden of showing that, in each situation (i) to (iv), the inventions are unrelated; therefore, the restriction requirement is not proper and cannot be maintained.

When the Examiner asserts that the inventions are unrelated, the M.P.E.P specifically requires that a well-reasoned factual basis for the conclusion must be provided. The M.P.E.P. 808.01 states: “[T]he facts relied upon for this conclusion [of independence] are in essence the reasons for insisting upon restriction.” (emphasis omitted.) In each of the present situations listed above, the Examiner has failed to provide even one fact relied upon in making his determination that the paired Groups encompass inventions that are independent from one another. The Examiner merely states in a conclusory fashion that “the metes and boundaries [of the claims] are distinct.”

Applying the rule cited by the Examiner (M.P.E.P §§ 806.04 and 808.01) it is apparent, in each case, that the paired groups *do not* describe inventions that are unrelated. According to the Examiner's interpretation, unrelated/independent inventions are those "not disclosed as capable of use together and have different modes of operation, different functions, or different effects." Paper No.8, ¶¶ 2-4 and 7 (emphasis added). In the case of the present claims, all are capable of use together, and are clearly disclosed as being so. For example, the composition (Group I) is capable of use in the method of Group II. Similarly, it is apparent from the specification that the article of Group III may result from the method of Group II, and the copolymer of Group IV can be used to produce the articles of Group III. The Examiner has failed to provide any factual underpinning for his conclusion that the inventions of the paired Groups are unrelated, because no such facts exist.

In view of at least the fact that the Examiner has failed to meet his burden of showing that the inventions of each: (i) of Groups I and II; (ii) of Groups II and III; (iii) of Groups III and IV; and (iv) of Groups II and IV, are unrelated, it is respectfully submitted that the restriction requirement with respect to at least the situations listed as (i) and (iv) is improper and cannot be imposed. Accordingly, its reconsideration and withdrawal of the restriction requirement are respectfully requested.

PROVISIONAL ELECTION

While the applicants disagree with the Examiner's requirement and his arguments in support thereof, they hereby provisionally elect the claims of Group I (claims 1-19) drawn to a composition for coating surfaces in response to the written restriction requirement. Additionally, the applicants reserve the right to file a subsequent divisional application containing any or all of the remaining claims.

The Examiner is respectfully requested to contact the undersigned at the telephone number indicated below regarding any questions that may arise. Reconsideration and

early examination of the claims are respectfully requested.

Respectfully submitted,

ROBERT A. ROSANIA *et al.*

16 August 2002 By: *Kristyne A. Bullock*
(Date)

KRISTYNE A. BULLOCK

Registration No. 42,371

AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P.

One Commerce Square

2005 Market Street, Suite 2200

Philadelphia, PA 19103

Telephone: (215) 965-1200

Direct Dial: (215) 965-1348

Facsimile: (215) 965-1210

E-Mail: kbullock@akingump.com

KAB/vj